

REMARKS

Entry of the foregoing amendment is respectfully requested.

Summary of Amendments

By the foregoing amendment, claim 64 is amended, whereby all of claims 64-109 of record will remain pending, with claims 64, 87 and 99 being independent claims.

Support for amended claim 64 can be found throughout the present specification and in particular, page 7 thereof.

Applicants point out that the amendment to claim 64 is without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute claim 64 in its original, unamended form in one or more continuation and/or divisional applications.

Summary of Office Action

Initially, Applicants note that the Examiner has failed to indicate consideration of the Information Disclosure Statement filed April 10, 2006 by returning a signed and initialed copy of the Form PTO-1449 submitted therein. Accordingly, the Examiner is respectfully requested to return a signed and initialed copy of the Form PTO-1449 submitted in the Information Disclosure Statement filed April 10, 2006 with the next official communication.

Claims 64 and 74 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Woodward et al., U.S. Patent No. 3,726,825 (hereafter "WOODWARD").

Claims 64, 68, 69, 71, 72, 74 and 78 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kantner et al., U.S. Patent No. 6,433,073 (hereafter "KANTNER").

Claims 64-75, 77, 78, 87-92, 94 and 99-104 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderle et al., U.S. Patent Application No. 2002/0028875 (hereafter "ANDERLE") in view of Kim et al., U.S. Patent No. 6,372,876 (hereafter "KIM"), in view of Stein et al., U.S. Patent No. 5,399,563 (hereafter "STEIN"), and in view of the Handbook of Cosmetic Science and Technology (hereafter "HANDBOOK").

Claims 79-86, 95-98 and 105-109 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN and HANDBOOK and further in view of Koch et al., U.S. Patent No. 6,258,963 (hereafter "KOCH").

Claims 76 and 93 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN and HANDBOOK and further in view of Gers-Barlag et al., U.S. Patent No. 5,725,844 (hereafter "GERS-BARLAG").

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested in view of the foregoing amendment and the following remarks.

Response to Rejection under 35 U.S.C. § 102(b) Over WOODWARD

Claims 64 and 74 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WOODWARD. The rejection alleges that WOODWARD discloses oil-in-water polyurethane compositions and also discloses that the oil-in-water emulsions comprising film-forming water soluble or water-dispersible polyurethanes have properties such as water resistance, solvent resistance when applied as coating to paper, paperboard, plastic film etc.

While Applicants respectfully disagree with the Examiner with respect to the alleged anticipation of independent claim 64 (and claim 74 dependent therefrom) by WOODWARD, claim 64 has been amended to additionally recite therein that the polyurethane has a K value of from 15 to 100. Since WOODWARD does not appear to disclose any K values of the polyurethanes described therein this document is unable to anticipate claims 64 and 74 for this reason alone.

Applicants submit that in view of the foregoing, withdrawal of the rejection of claims 64 and 74 under 35 U.S.C. § 102(b) over WOODWARD is warranted and respectfully requested.

Response to Rejection under 35 U.S.C. § 102(e) Over KANTNER

Claims 64, 68, 69, 71, 72, 74 and 78 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by KANTNER. The rejection alleges that KANTNER discloses oil-in-water cosmetic compositions which comprise a film-forming polyurethane and have properties such as water-resistance and transfer resistance. The rejection further points to Tables XVI and XVII in column 27 of KANTNER in this regard.

While Applicants respectfully disagree with the Examiner with respect to the alleged anticipation of independent claim 64 (and claims 68, 69, 71, 72, 74 and 78 dependent therefrom) by KANTNER, claim 64 has been amended to additionally recite therein that the polyurethane has a K value of from 15 to 100. Since KANTNER does not appear to disclose any K values of the polyurethanes described therein this document is unable to anticipate claim 64 and any of the claims dependent therefrom for this reason alone.

Applicants submit that in view of the foregoing, withdrawal of the rejection of claims 64 and 68, 69, 71, 72, 74 and 78 under 35 U.S.C. § 102(b) over KANTNER is warranted and respectfully requested.

Response to Rejections under 35 U.S.C. § 103(a)

Claims 64-75, 77, 78, 87-92, 94 and 99-104 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN and HANDBOOK. Claims 79-86, 95-98 and 105-109 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN and HANDBOOK and further in view of KOCH. Claims 76 and 93 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ANDERLE in view of KIM, STEIN and HANDBOOK and further in view of GERS-BARLAG. The rejection essentially repeats the assertions set forth in the Office Action mailed October 17, 2005.

Applicants respectfully traverse these rejections for at least all of the reasons which have already been set forth in the Amendment filed April 10, 2006 in response to the October 17, 2005 Office Action. The corresponding remarks are incorporated herein in their entirety.

Specifically, in the Amendment filed April 10, 2006 Applicants submitted a verified English language translation of the priority document of the present application (German Application 100 63 130.4, which fully supports the present claims) and pointed out that ANDERLE, a document under 35 U.S.C. § 102(e), was filed after the filing date of the German priority application (December 18, 2000), wherefore only the provisional application on which ANDERLE is based (No. 60/219,560 filed July 20, 2000) can qualify as prior art for any of the

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present claims. This provisional application (a copy of which was also submitted together with the Amendment filed April 10, 2006) does, however not contain the passages of ANDERLE on which the present rejections are primarily based. For example, the provisional application does not contain paragraphs [0070] and [0262] of ANDERLE.

Further, the provisional application fails to teach or suggest, for example, any cosmetic O/W formulations, let alone formulations which comprise a UV filter substance. The provisional application also fails to teach or suggest that the polyurethane dispersions described therein improve the water resistance of any substrate to which they are applied.


None of the remaining documents cited by the Examiner cures the deficiencies of the provisional application of ANDERLE for at least all of the reasons that have been set forth in the Amendment filed April 10, 2006. In view thereof, Applicants submit that the present rejections under 35 U.S.C. § 103(a) are without merit, wherefore withdrawal thereof is warranted and respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,

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